

REMARKS/ARGUMENTS

Claims 1-18 are pending. Claims 12, 17, and 18 are amended. Support for the amendments to claims 12, 17, and 18 can be found in the specification on page 14, lines 24-27. No new matter is added.

I. 35 U.S.C. § 101: Asserted Non-Statutory Subject Matter

The examiner rejected claims 12, 17, and 18 under 35 U.S.C. § 101 as directed towards non-statutory subject matter. Applicants have amended these claims accordingly to recite a tangible medium. Therefore, this rejection is overcome.

II. 35 U.S.C. § 103: Asserted Obviousness

II.A. Claims 1-8 and 10-12

The examiner rejects claims 1-8 and 10-12 as obvious under 35 U.S.C. § 103 over *Holvey, et al., Method and System for Protecting Information on a Computer System*, U.S. Patent Application Publication 2004/0054935 (March 18, 2004) (hereinafter “*Holvey*”) in view of *Prihoda, et al., Secure Data Processing Method*, U.S. Patent 6,789,195 (September 7, 2004) (hereinafter “*Prihoda*”). This rejection is respectfully traversed. The examiner states that:

6. Regarding claims 1, 11 and 12: Holvey discloses a data processing system (Title), method (Title), and an executable computer program on a tangible medium ([0038] software), respectively, for controlling access of at least one user to stored data comprising:

means, responsive to a request from the user to access a set of the stored data that is available to the at least one user, for authenticating the user ([0022] requesting user authenticated via voice-print or ID and password); and

a user specific table associated with the user (patient medical records and associated authorized users), wherein the user specific table identifies the set ([0023]-[0024] Table 1).

Holvey does not disclose decrypting the user specific table or accessing the set in response to successful decryption.

Prihoda discloses means, responsive to successful authentication, for decrypting a user specific table associated with the user (col. 1, 11. 57-65, storage.. data.. decrypted..); and means, responsive to successful decryption, for accessing the set (col. 2, 11. 15-20, authorized data access with key...).

As one of ordinary skill in the art at the time of the invention would know, encrypting documents has been well-known since long before the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by encrypting and decrypting data as

taught by Prihoda in order to maintain confidentiality of users' information. (see Prihoda col. 2 ll. 15-16).

Office action of July 31, 2007, pp. 4-5 (emphasis in original).

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). "*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006))."

II.A.1. The Proposed Combination Does Not Teach or Suggest All of the Features of Claim 1

Applicants first address the rejection of claim 1. Claim 1 is as follows:

1. (Previously Presented) A data processing system for controlling access of at least one user to stored data, the data processing system comprising:
 - means, responsive to a request from the user to access a set of the stored data that is available to the at least one user, for authenticating the user;
 - means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set; and
 - means, responsive to successful decryption, for accessing the set.

The examiner has failed to state a *prima facie* obviousness rejection against claim 1 because the proposed combination of the references, when considered as a whole, does not teach all of the features of claim 1. Specifically, the proposed combination, considered as a whole, does not teach the features of, "means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set," as required by claim 1.

Referring to, "patient medical records and associated authorized users," (Office action of July 31, 2007, p. 4) the examiner relies on *Holvey* to teach this claim feature. Specifically, the examiner asserts

that the following portions of *Holvey*, in conjunction with the examiner's assertion, teach this claim feature (Applicants address the *Prihoda* portion of the combination further below):

[0023] In the preferred embodiment of the present invention the security system supports multiple levels of user access. The owner of the medical records, identified as the patient, has the most complete set of rights. The patient can create users with surrogate rights. With the exception of access to certain information designated as private by the patient, surrogate users have the same access rights as the patient. In addition to read access to the medical records, the patient and surrogate user have write access to selected portions of the patient's medical and configuration records. Both the patient and surrogate users have the right to create additional users. The other three types of users are the provider that has write access to selected portions of the patient's medical and configuration records, the provider that does not have such write access, and the limited user. The surrogate, provider, and limited users have read access rights to all medical records except the records that the patient has designated as private records or as records not available to certain levels of user access. Table 1 below summarizes the access rights of each type of user to the patient's medical records. The users for each access level in Table 1, i.e., patient, surrogate, provider with write access, provider without write access, and limited, are all considered authorized users.

TABLE 1

Access Levels	Access Rights				
	Assign (create) new users to access patient's account?	Schedule a specific time for viewing patient's medical records online?	Edit patient's records and distribute records to another party?	View patient's "Private" pages?	View patient's son "Private" pages?
Patient	YES	YES	YES	YES	YES
Surrogate	YES	YES	YES	NO	YES
Provider- Level 1	NO	YES	YES	NO	YES
Provider- Level 2	NO	YES	NO	NO	YES
Limited	NO	NO (*)	NO	NO	YES

(*) The patient or surrogate user must schedule a session for the limited rights user.

[0024] The time during which a patient's medical records are accessible on-line, i.e., the access period, is scheduled by voice and menu-based telephone instructions to a service provider's fully automated voice recognition unit (VRU) or service provider agent.

The patient and the surrogate user can schedule access periods for all users in Table 1. The provider can schedule his/her own access period. Access periods for limited-rights users are available only when scheduled by a patient or a surrogate user. Note that a patient's medical records are not on-line during the entire access period, but only need to be on-line when an authorized scheduled user is logged into the Internet Web Server.

Holvey, paragraphs 0023, 0024, and Table 1.

As explained in the prior pre-appeal brief request, the examiner's assertions regarding these teachings vis-à-vis claim 1 are clearly erroneous. The cited portion of *Holvey* plainly does not teach or suggest the claim feature of, "means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set," as specified in claim 1. In fact, nothing in *Holvey* teaches or suggests this claim feature.

A plain reading of paragraphs 23 and 24 shows that no basis exists to assert that the patient medical records are a “user specific table.” The information may relate to specific users, but *Holvey* is completely silent on how the information is stored. *Holvey* simply does not state or imply that the information is in the form of a user specific table and *Holvey* gives no hint or suggestion that the information should be stored in a user specific table.

Holvey does provide a “table” in the form of table 1. However, table 1 describes “the access rights of each type of user to the patient's medical records.” Thus, table 1 refers to an exemplary set of access rights belonging to *types* of users. *Holvey* does not refer to *user specific* tables, but rather to *types* of users. Additionally, and even more importantly, *Holvey* does not state and does not give any hint or suggestion that table 1 is actually stored in the form of a user specific table. *Holvey* does not describe how the information is stored at all. In light of the fact that, in the art, such information is usually stored in massive relational databases or object oriented databases, no reasons exists to assume that the rights shown in table 1 are stored in a *user specific* table. Thus, *Holvey* does not teach or suggest the claimed feature of, “means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set.”

Additionally, *Prihoda* also does not teach or suggest this claimed feature. Instead, the plain disclosure of *Prihoda* directly contradicts the examiner's assertions. *Prihoda* specifically states that users access a *centralized database*. See *Prihoda*, col. 1, ll. 57-65 (the very portions of *Prihoda* cited by the examiner). Thus, *Prihoda* does not decrypt a *user specific table*, as asserted by the examiner, but rather teaches the opposite - a *centralized database*.

Accordingly, the examiner appears to have ignored the plain teachings of *Prihoda* when fashioning the rejection. Ignoring the plain teachings of *Prihoda* fails to comport with the requirements of *KSR Int'l*. to look to the interrelated teachings of the art. For this reason, the examiner failed to state a *prima facie* obviousness rejection against claim 1.

As shown above, neither *Prihoda* nor *Holvey* teach or suggest all of the features of claim 1. For this reason, the proposed combination of references, considered as a whole, does not teach or suggest all of the features of claim 1. For this reason also, under the standards of *In re Royka*, the examiner failed to state a *prima facie* obviousness rejection against claim 1.

II.A.2. The Examiner Failed To State a Proper Reason To Achieve the Legal Conclusion of Obviousness under the Standards of *KSR Int'l*.

Additionally, the examiner failed to state a *prima facie* obviousness rejection against claim 1 because the examiner failed to state a proper reason to achieve the legal conclusion of obviousness under the standards of *KSR Int'l*. Regarding a reason to combine the references, the examiner states that:

As one of ordinary skill in the art at the time of the invention would know, encrypting documents has been well-known since long before the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users' information. (see Prihoda col. 2 ll. 15-16).

Office action of July 31, 2007, p. 4.

However, the examiner's statement self-evidently does not satisfy the requirements of *KSR Int'l*. The Court in *KSR Int'l*. states that, "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, *all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.*" *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). "*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006))."

In the case at hand, the examiner makes only a conclusory statement that provides no articulated reasoning and provides no rational underpinning to support the legal conclusion of obviousness. Instead, the examiner only states that the combination would be obvious "in order to maintain confidentiality of users' information."

The examiner's statement is conclusory because the examiner provides no connecting logic between the asserted advantage and the legal conclusion of obviousness. For similar reasons, the examiner's statement provides no rational underpinning to support the legal conclusion of obviousness. The examiner only states a purported advantage to combine the references. However, the examiner does not provide any technical or other rational connection between the purported advantage and the legal conclusion of obviousness. Instead the examiner simply states the purported advantage and then assumes that the reader would recognize that the purported advantage would somehow compel the legal conclusion that claim 1 is obvious in view of the references. However, this assumption fails to comport with the requirements of *KSR Int'l* that the examiner provide articulated reasoning with a rational underpinning to achieve the legal conclusion of obviousness in view of the references.

As a specific example that applies to the case at hand, the "idea" of encrypting information, and databases, has existed for *decades*. However, despite the value of the claimed inventions, no one of ordinary skill has produced the claimed inventions or produced a product including the claimed inventions. Had a reason existed to combine the references to achieve the invention of claim 1, someone would already have made the claimed invention. Therefore, *no reason whatsoever* exists to connect the

advantage of encryption/ decryption with *Holvey* in such a manner that compels the *legal conclusion* that claim 1 is obvious. This example shows that when the logical gaps between the examiner's statement and the legal conclusion of obviousness are examined, the opposite conclusion arises - that *claim 1 is non-obvious in view of the references considered as a whole*.

In any case, the examiner's statement is both conclusory and provides no articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Accordingly, under the standards of *KSR Int'l*, the examiner failed to state a *prima facie* obviousness rejection against claim 1 or any other claim.

II.A.3. Both *Holvey* and *Prihoda* Teach Away from the Invention of Claim 1

In addition, the examiner has failed to establish a *prima facie* obviousness rejection against claim 1 because no proper reason exists under the standards of *KSR Int'l*. to combine the references in the manner suggested by the examiner. No proper reason exists to combine the references exists because both *Holvey* and *Prihoda* teach away from claim 1.

As described above, both *Holvey* and *Prihoda* provide for techniques of working with *centralized databases*. In stark contrast, claim 1 requires use of a *user-specific table*. Thus, one of ordinary skill would immediately recognize that both *Holvey* and *Prihoda* are wholly inappropriate to the method described in claim 1. Additionally, when considering these references as a whole, one of ordinary skill would be motivated to avoid combining the references in a manner that results in a *user specific table*, because these references tout the advantages of maintaining a centralized database.

For this reason, both *Holvey* and *Prihoda* teach away from the method of claim 1. Accordingly, no proper reason exists to combine the references to achieve the legal conclusion of obviousness, as required by *KSR Int'l*. Indeed, a strong motivation exists to *avoid* combining the references to achieve the claimed invention, which recites a *user-specific table*, because the references tout the advantages of maintaining a *centralized database*. Therefore, under the standards of *KSR Int'l*, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

II.B. Claim 9

The examiner rejects claim 9 under 35 U.S.C. § 103 as obvious over *Holvey*, *Prihoda*, and *Chadwick*, *Smart Cards Aren't Always the Smart Choice*, IEEE Computer, December 1999, v. 32, issue 12, pp. 142-143 (hereinafter "Chadwick"). This rejection is respectfully traversed. The examiner states that:

8. Regarding claim 9: Holvey discloses a token ([0022]). Holvey does not disclose the token comprising the means for decrypting. Prihoda discloses a

token comprising the means for decrypting (Abstract and col. 2, 11. 15-20, key for decrypting).

As one of ordinary skill in the art at the time of the invention would know, software tokens have been well-known since long before the invention, (see Chadwick, p. 142, col. 1-2, regarding public/private key infrastructure software tokens). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users' information, (see Prihoda, col. 3 11. 20-21).

Office action of July 31, 2007, pp. 5-6 (emphasis in original).

The rejection of claim 9 relies on the combination of *Holvey* and *Prihoda*. Therefore, the examiner failed to state a *prima facie* obviousness rejection against claim 9 for the same reasons the examiner failed to state a *prima facie* obviousness rejection against claim 1.

Additionally, Chadwick adds nothing to the combination of *Holvey* and *Prihoda* regarding the claimed feature of, "means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set." Chadwick is directed towards describing the advantages and disadvantages of "smart cards." Chadwick is wholly devoid of disclosures regarding user specific tables. Therefore, the combination of *Holvey*, *Prihoda*, and Chadwick does not teach or suggest all of the features of the claims. Accordingly, under the standards of *In re Royka*, the examiner failed to state a *prima facie* obviousness rejection against claim 9.

Additionally, vis-à-vis the requirement of a rational reason to arrive at the legal conclusion of obviousness, the examiner engages in the same conclusory reasoning that fails to comport with the requirements of *KSR Int'l*. The examiner believes, again, that obviousness is compelled simply by virtue of the existence of the advantage to "maintain confidentiality of users' information." However, the examiner fails to cite any reason to connect this purported advantage to compel the *legal conclusion* of obviousness. Accordingly, the examiner failed to state a *prima facie* obviousness rejection against claim 9.

Furthermore, the examiner's statements are overly broad to serve as a proper reason to combine the references to achieve the legal conclusion of the obviousness of claim 1. Under the examiner's reasoning *any* reference that deals with computer security could be combined with *Holvey* to achieve the legal conclusion of obviousness. This fact shows that the examiner's statements fail to comport with the standards of *KSR Int'l*. Accordingly, again, the examiner failed to state a *prima facie* obviousness rejection against claim 9.

II.C. Claims 13-18

The examiner rejects claims 13-18 under 35 U.S.C. § 103 as obvious over *Holvey*, *Prihoda*, and *Mita* et al., Medical Data Sharing Method and Medical Data Sharing System Using the Method, U.S. Patent Application Publication 2002/0035485 (March 21, 2002) (hereinafter “*Mita*”). This rejection is respectfully traversed. The examiner states that:

10. Regarding claims 13, 15 and 17: Holvey discloses additional user specific tables for each additional user ([0007] patient database, i.e., collection of patient tables).

Mita discloses means for attempting to decrypt, in turn, each of the user specific tables until a successful decryption occurs ([0042] sequential search).

As one of ordinary skill in the art at the time of the invention would know, sequential searching has been well-known since long before the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Holvey* by sequential searching as taught by *Mita* in order to access stored personal including medical data (see *Mita*, Title).

Office action of July 31, 2007, p. 6 (emphasis in original).

The rejection of claim 13 relies on the combination of *Holvey* and *Prihoda*. Therefore, the examiner failed to state a *prima facie* obviousness rejection against claim 13 for the same reasons the examiner failed to state a *prima facie* obviousness rejection against claim 1.

Additionally, *Mita* adds nothing to the combination of *Holvey* and *Prihoda* regarding the claimed feature of, “means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set.” *Mita* is directed towards a method of sharing medical information over a network. *Mita* is wholly devoid of disclosures regarding user specific tables. Therefore, the combination of *Holvey*, *Prihoda*, and *Mita* does not teach or suggest all of the features of the claims. Accordingly, under the standards of *In re Royka*, the examiner failed to state a *prima facie* obviousness rejection against claim 13 or the remaining claims.

Additionally, vis-à-vis the requirement of a rational reason to arrive at the legal conclusion of obviousness, the examiner engages in the same conclusory reasoning that fails to comport with the requirements of *KSR Int'l*. The examiner believes that obviousness is compelled simply by virtue of the existence of the advantage of accessing stored personal data including medical data. However, the examiner fails to cite any reason to connect this purported advantage to compel the *legal conclusion* of obviousness. Accordingly, the examiner failed to state a *prima facie* obviousness rejection against claim 13.

III. Conclusion

The subject application is patentable over the cited references and should now be in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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